

REMARKS/ARGUMENTS

Reconsideration of this application as amended is respectfully requested.

Claims 1-12, 14-30, and 32-36 are pending in the present patent application.

Additionally, claims 1, 14, 19, 24-25, and 35-36 have been amended and no new matter has been added. Claims 13 and 31 have been canceled and new claims 37 and 38 have been added. Accordingly, claims 1-12, 14-30, and 32-38 are now pending in the present application. Applicants find support for the claims generally throughout the specification, specifically on pages 5-12 and in Figures 1-5.

Applicants reserve all rights with respect to the applicability of the doctrine of equivalents.

The Examiner has objected to the drawings and has stated that:

“Figure 1 should be designated by a legend such as –Prior Art—because only that which is old is illustrated. See MPEP §608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the Examiner, the Applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.”

Accordingly, Applicants have labeled “Prior Art” above Figure 1 and have provided replacement drawings at the end of this action.

The Examiner has also stated that :

“the Information Disclosure Statement filed August 18, 2003 has been considered.”

The Examiner has rejected claims 19-36 under 35 U.S.C. 101:

“because the claimed invention is directed to non-statutory subject matter. The current focus of the Patent Office in regard to statutory inventions under 35 U.S.C. 101 for method claims and claims that recite a judicial exception (software) is

that the claimed invention recite a practical application. Practical application can be provided by a physical transformation or a useful, concrete and tangible result. No physical transformation is recited and additionally, the final result of the claim is for providing an image which is not a tangible result because the claims do not explicitly claim the result being on a computer readable medium.”

Applicants have amended claims 19-36 such that the term “computer readable medium” is replaced with “compute-readable storage medium.” Applicants respectfully submit that one having ordinary skill in the art will readily understand the meaning and scope of the term “computer-readable storage medium” Furthermore, the term “computer-readable storage medium” claims are recognized as an accepted type of claim, similar to “method,” “system,” and “device,” claims. Moreover, the term “computer-readable storage medium” is a physical thing because it may identify an area of which data is stored and therefore is a “computer element which define structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory (MPEP 2106.01).”

The Examiner has rejected claims 1-36 under 35 U.S.C. 102(b):

“as being anticipated by DERIVE: A Tool That Automatically Reverse-Engineers Instruction Encodings, Dawson R. Engler et al., ACM, 2000, pages 12-22.”

Regarding claim 1, the Examiner states that:

“Abstract, page 1, Reverse Engineering – installed software)” and Derive, Conclusion, page 19, instruction encoding and page 22, encoding structure, Figure 5 – emitter specification).”

Regarding claim 2, the Examiner states that: **“as per claim 1 and DERIVE, page 21-22, criteria for the scan).**

Regarding claim 3, the Examiner states **“as per claim 1.”**

Regarding claim 4, the Examiner states **“as per claim 1.”**

Regarding claim 5, the Examiner states **“DERIVE Abstract, second paragraph and page 12 right side third paragraph.”**

Regarding claim 6, the Examiner states **“as per claim 1.”**

Regarding claim 7, the Examiner states **“as per claim 1.”**

Regarding claim 8, the Examiner states **“as per claim 5.”**

Regarding claim 9, the Examiner states **“as per claim 1.”**

Regarding claim 10, the Examiner states **“DERIVE, the derived specification in the Abstract as per claim 1.”**

Regarding claim 11, the Examiner states **“as per claim 1.”**

Regarding claim 12, the Examiner states **“as per claims 1 and 5.”**

Regarding claim 13, the Examiner states **“as per claim 1.”**

Regarding claim 14, the Examiner states **“as per claim 5.”**

Regarding claim 15, the Examiner states **“as per claim 5.”**

Regarding claim 16, the Examiner states **“as per claim 5.”**

Regarding claim 17, the Examiner states **“as per claim 1.”**

Regarding claim 18, the Examiner states **“as per claim 5.”**

Regarding claim 19, the Examiner states **“as per the rejection for claim 1.”**

Regarding claim 20, the Examiner states **“as per the rejection for claim 2.”**

Regarding claim 21, the Examiner states **“as per the rejection for claim 3.”**

Regarding claim 22, the Examiner states **“as per the rejection for claim 4.”**

Regarding claim 23, the Examiner states **“as per the rejection for claim 5.”**

Regarding claim 24, the Examiner states **“as per the rejection for claim 6.”**

Regarding claim 25, the Examiner states **“as per the rejection for claim 7.”**

Regarding claim 26, the Examiner states **“as per the rejection for claim 8.”**

Regarding claim 27, the Examiner states **“as per the rejection for claim 9.”**

Regarding claim 28, the Examiner states **“as per the rejection for claim 10.”**

Regarding claim 29, the Examiner states **“as per the rejection for claim 11.”**

Regarding claim 30, the Examiner states **“as per the rejection for claim 12.”**

Regarding claim 31, the Examiner states **“as per the rejection for claim 13.”**

Regarding claim 32, the Examiner states **“as per the rejection for claim 14.”**

Regarding claim 33, the Examiner states **“as per the rejection for claim 15.”**

Regarding claim 34, the Examiner states **“as per the rejection for claim 16.”**

Regarding claim 35, the Examiner states **“as per the rejection for claim 17.”**

Regarding claim 36, the Examiner states **“as per the rejection for claim 18.”**

The Examiner has also rejected claims 5, 7, 14-16, 18, 23, 25, 32-34, and 36 under 35 U.S.C. 103(a):

“as being unpatentable over DERIVE in view of Modular Type-Based Reverse Engineering of Parameterized Types in Java Code, Dominic Duggan, ACM, 1999, pages 97-113.

Motivation to Combine DERIVE and JAVA

DERIVE teaches the emitting of C code (DERIVE, page 22). C code is not universally known to be platform independent. It is JAVA who teaches a well known platform independent language. Therefore, it would have been obvious to one of ordinary skill in the art to combine DERIVE and JAVA, because reverse engineering for a language like JAVA which is platform independent by the implantation of a virtual machine, would make a reverse engineering tool more flexible.

Regarding claims 5 and 23, the Examiner states that:

“the method of claim 4 wherein the at least one software program is hardware independent (JAVA, page 97, introduction).”

In regards to claims 7 and 25, the Examiner states that:

“the method of claim 6 wherein the plurality of software programs comprises a combination of hardware-independent and hardware-dependent software programs. As per claim 5.”

Regarding claims 14 and 32, the Examiner states that:

“the method of claim 13 wherein the software program is hardware independent application software. (JAVA, page 97, Introduction).”

In regards to claims 15 and 33, the Examiner states that:

“the method of claim 14 wherein the hardware-independent application software is a hardware-independent imaging tool. (JAVA, page 97, Introduction).”

Regarding claims 16 and 34, the Examiner states that:

“the method of claim 1 wherein the module is hardware independent. (JAVA, page 97, Introduction).”

In regards to claims 18 and 36, the Examiner states that:

“the method of claim 17 wherein the plurality of modules comprise a combination of hardware-independent and hardware-dependent modules. (JAVA, page 97, Introduction).”

ARGUMENTS

35 U.S.C. §102(b)

Applicants respectfully submit that claim 1 is not anticipated by DERIVE and have amended claim 1 to read as follows:

A method for providing an image of software installed on a computer system, the method comprising the steps of:

- (a) deconstructing the image into at least one portion;
 - (b) creating at least one module from the at least one portion of the image; and
 - (c) formatting the at least one module for use in a new image or at least a portion of a new image.
- (emphasis added)

Applicants respectfully submit that DERIVE fails to disclose a method for providing an image of software installed on a computer system including the steps of deconstructing the image into at least one portion, creating at least one module from the at least one portion of the image, and formatting the at least one module for use in a new image or at least a portion of a new image, as referred to in amended claim 1.

Applicants find support for a method providing an image of software installed on a computer system comprising the step of formatting the at least one module for use in a new image or at least a portion of a new image in the specification on page 10.

It is the Examiner's position that DERIVE anticipates claim 1. Applicants respectfully traverse this rejection.

First, the Examiner states that DERIVE discloses a method for providing an image of software installed on a computer system comprising the step of deconstructing the image into at least one portion in the **Abstract on page 1**. The Examiner also states that the method comprises creating at least one module from the at least one portion of the image in the **"conclusion on page 19, instruction encoding and page 22, encoding structure 5 – emitter specification).**" However, Applicants submit that DERIVE discloses a method of reverse-engineering instruction encodings from pre-existing software (the system assembler) and uses the information extracted to construct dynamic linking libraries, object-level sandboxers, executable optimizers, and linkers. Applicants submit that the aforementioned method and applications are not equivalent to a method for providing an image of software installed on a computer system comprising the step of formatting the at least one module for use in a new image or at least portion of a new image. Furthermore, Applicants submit that DERIVE fails to disclose a formatting

method of a image or module to be used with a software program. Therefore, Applicants submit that DERIVE fails to anticipate claim 1.

Given that claims 2-12 and 14-18 are dependent claims that depend directly or indirectly on independent claim 1, and add additional limitations, Applicants respectfully submit that claims 2-18 are not unpatentable under 35 U.S.C. 102(b).

Applicants respectfully submit that claim 19 is not anticipated by DERIVE and have amended claim 19 to read as follows:

A computer-readable storage medium including a computer program for providing an image of software installed on a computer system, comprising instructions for:

- (a) deconstructing the image into at least one portion;
- (b) creating at least one module from the at least one portion of the image; and
- (c) formatting the at least one module for use in a new image or at least a portion of a new image.

(emphasis added)

Applicants respectfully submit that DERIVE fails to disclose a computer-readable storage medium including a computer program for providing an image of software installed on a computer system, comprising instructions for deconstructing the image into at least one portion, creating at least one module from the at least one portion of the image, and formatting the at least one module for use in a new image or at least a portion of a new image. That is, claim 19 refers to a computer-readable medium comprising computer instructions for formatting the at least one module for use in a new image or at least a portion of a new image.

As previously stated in regards to claim 1 above, Applicants submit that DERIVE discloses a method of reverse-engineering instruction encodings from pre-existing software (the system assembler) and uses the information extracted to construct dynamic

linking libraries, object-level sandboxers, executable optimizers, and linkers. However, Applicants submit that the aforementioned method and applications are not equivalent to a software program comprising computer instructions for formatting the at least one module for use in a new image or at least a portion of a new image. Furthermore, Applicants submit that DERIVE fails to disclose a formatting method of an image or module to be used within a computer-readable storage medium. Therefore, Applicants submit that DERIVE fails to anticipate claim 19.

Additionally, given that claims 20-30 and 32-36 are dependent claims that depend directly or indirectly on independent claim 19 and add additional limitations, Applicants respectfully submit that claims 20-30 and 32-36 are not unpatentable under 35 U.S.C. 102(b).

35 U.S.C. §103(a)

The Examiner has rejected claims 5, 7, 14, 15, 16, 18, 23, 25, 32, 33, 34, and 36 as being unpatentable under DERIVE in view of Modular Type-Based Reverse Engineering of Parameterized Types in Java Code, Dominic Duggan, ACM, 1999, PAGES 97-113 (JAVA). However, the aforementioned claims are dependent claims that depend directly or indirectly on independent claims 1 and 19 and add additional limitations. Therefore, applicants respectfully submit that the aforementioned claims are not unpatentable under 35 U.S.C. §103(a) under DERIVE in view of JAVA.

NEW CLAIMS

Applicants have added new claims 37 and 38 and believe that they are patentable, are in the scope of this application, and add no new matter.

Claim 37 refers to a method of providing an image of software installed on a computer system comprising the step of formatting an at least one module for use in at least a portion of a new image. Applicants believe that claim 37 is patentable for reasons similar to those given for claim 1.

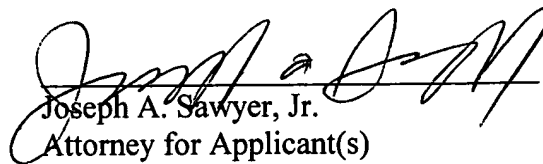
Claim 38 refers to a computer-readable storage medium including a computer program for providing an image of software installed on a computer system, comprising instructions for formatting an at least one module for use in at least a portion of a new image. Applicants believe that claim 38 is patentable for reasons similar to those given for claim 19.

Applicant's attorney believes that this application is in condition for allowance. Should any unresolved issues remain, Examiner is invited to call Applicant's attorney at the telephone number indicated below.

Respectfully submitted,

SAWYER LAW GROUP LLP

December 4, 2006
Date


Joseph A. Sawyer, Jr.
Attorney for Applicant(s)
Reg. No. 30,801
(650) 493-4540